UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,985	02/02/2002	Bettina Kuppinger	YOR920010745US1	5276

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EXAMINER
HUYNH, THU V

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/066,985	KUPPINGER ET AL.
	Examiner	Art Unit	
	Thu V. Huynh	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 August 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>02 February 2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: RCE filed on 8/21/05 to application

filed on 02/02/2002.

2.   Claims 1, 14 and 20 are amended.

3.   Claims 1-20 are pending in the case. Claims 1, 14, and 20 are independent claims.

4.   The rejections in the previous office action have been withdrawn in view of the

amendment.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35
U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly
owned at the time any inventions covered therein were made absent any evidence to the contrary.
Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates
of each claim that was not commonly owned at the time a later invention was made in order for the
examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)
prior art under 35 U.S.C. 103(a).

6.   **Claims 1-7, 10-12, 14-18, 20 are rejected under 35 U.S.C. 103(a) as being**

Unpatentable over ScanWise 2.00 Print out (hereinafter Printout), copyright 2001,

pages 1-28 (pages 1-20 are the same as previous provided), in view of Ferguson et

al., US 6,810,404 B1, filed 10/1997.

Regarding independent claim 1, Printout teaches the steps of:

- receiving a request to image a document through an electronic cover that holds data elements related to the document content, wherein the data elements are dynamic to reflect updates to the document content (Printout, pages 1-9; requests to scan an image through an electronic cover on the right hand side of scanwise application by clicking on "scan" button. The user is able to enter "Destination", "Image Control", "Dimensions" and/or "Advanced" information for scanning the image. In "Image Control", when the user selects "Color" mode, "Color Setting" appears and the image is displayed in color (Printout, page 21) and "Advanced" setting is only available at "Color" mode (Printout, pages 21, 24, 26). The user adjusts brightness, contrast and saturation for the image and the image is displayed based on such adjustments (Printout, pages 22-23). Similarly, when the user selects "Grayscale" or "Line Art" mode, different setting is displayed for the user adjusts and the image is displayed based on the user selections and adjustments (Printout, pages 24-27). In "Dimensions", the "Scale" and "Size" of the image are linked together so that when the user adjusts the scale of the image, the size of the image is adjusted as well. The "Scanned Image Size" and "Scanning Resolution" are automatically updated when the user adjusts the data (Printout, pages 5 and 28)).

- processing the cover of the document for validating the data elements related to the document (Printout, pages 1-12; validating data elements entered by the user for scanning the image according to the user desired inputs or adjustments);

- based on the validated data elements in the cover, automatically collecting data and populating at least some data fields in the cover by linking the at least some data fields to independent software applications (Printout, pages 1-14; automatically collecting data and linking the data to destination applications, such as Adobe Photoshop, Microsoft Photo, fax, printer, clipboard, etc.);

- storing at least some of the data populated in the cover for automatic reuse of the at least some of the data populated in the cover by integrated applications, to prevent re-entry of the at least some of the populated data in the integrated applications (Printout; pages 1-18; storing some of the entered data for automatically re-using by intergraded Photoshop, Microsoft office document imaging, etc. applications. The use enters the data once in Scanwise application. The entered data is available for reuse and avoid re-entry Adobe Photoshop and Microsoft office applications by pasting from the clipboard or scanning to applications, avoiding to re-entry of populated data in the integrated application), and for reuse of the at least some of the data populated in the cover as index values (Printout, pages 19-20; automatically indexing the populated data in other applications).

However, printout does not explicitly disclose index values to assist in storing the document and to further assist in searching for, and locating the document based on the document content.

Ferguson teaches user enters attribute data, such as document size, document type (color, black and white or gray scale), orientation, brightness, resolution for scanning a

document (Ferguson, figures 1, 5-7; col.9, lines 39-65); storing the scanned document

and document attributes, such as color, black and white or gray scale in indexing database

for searching and retrieving the document (Ferguson, figures 14-15; col.4, lines 7-27;

col.5, line 65 – col.6, line 25; col.10, lines 20-38; col.12, line 57 – col.13, line 6;

searching scanned document/image using file attributes wherein the document and

attributes are stored in indexing database).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Ferguson's teaching into Printout's teaching to

provide search features, since the combination would have allowed the user searching a

document based on data relate to the document such document attributes as Ferguson

disclosed.

Regarding dependent claim 2, which is dependent on claim 1. Printout teaches

automatically indexing the populated data in an imaging application (Printout, pages 19-

20; automatically indexing the populated data in the applications in order to displaying

the image).

Regarding dependent claim 3, which is dependent on claim 2, Printout teaches

the using the cover to review a submission (Printout, pages 2-7; user uses the cover to

review before scanning the image).

Regarding dependent claim 4, which is dependent on claim 2. Printout teaches using the cover to update a request status (Printout; pages 2-7; updating a scanning request by clicking on scan button).

Regarding dependent claim 5, which is dependent on claim 2. Printout teaches using the cover to initiate a workflow for subsequent processing (Printout, pages 2-9; using the cover to initial a workflow for scanning the image into a particular file).

Regarding dependent claim 6, which is dependent on claim 3, Printout teaches feeding collected data to one or more intergated software applications (Printout; pages 7-14, 19-20; feeding collected data to Photoshop, Microsoft Photo; fax, printer, clipboard, etc.).

Regarding dependent claim 7, which is dependent on claim 1, Printout teaches processing the electronic cover includes setting an electronic checklist to validate critical data elements related to the document (Printout, pages 2-7; electronic cover includes setting checklist).

Regarding dependent claim 10, which is dependent on claim 7. Printout teaches disclose the critical data elements include a mode of transmittal (Printout, page 3, transmiting to a file, fax, printer, etc.).

Regarding dependent claim 11, which is dependent on claim 7. Printout teaches the critical data elements include a new transaction (Printout, pages 2-7; new subject).

Regarding dependent claim 12, which is dependent on claim 7. Printout teaches the critical data elements include an update (Printout, pages 2-7; updating information).

Claims 14-15, 17 are for a computer program performing the method of claims 1-2, 7, respectively and are rejected under the same rationale.

Claim 16 is for a computer program performing the method of claim 3, 4 or 5, and is rejected under the same rationale.

Claim 18 is for a computer program performing the method of claim 9, 11 or 12, and is rejected under the same rationale.

Claim 18 is for a computer program performing the method of claim 10 and is rejected under the same rationale.

Claim 20 is for a data management device performing the method of claim 1 and is rejected under the same rationale.

7.   **Claims 8-9, 13, 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Printout in view of Ferguson</u> as applied to claims 1 and 7 above, and further in view of <u>Anderson</u> et al., US 2001/0054106 A1, provisional filed 23/2000.**

Regarding dependent claims 8 and 13. Printout does not explicitly teach the critical data elements include a customer number, or a customer master record.

Anderson teaches attaching extra information, such as invoice number, last payment date into a scanned image for reused by different applications (Anderson, [0020]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Anderson's extra information into Printout and Van Der to provide extra information which includes customer number, customer master record, invoice number or/and last payment date, etc. with the scanned image, since the combination would have allow different applications to use such information as Anderson disclosed.

Claim 18 is for a computer program performing the method of claim 8 and is rejected under the same rationale.

Regarding dependent claim 9, which is dependent on claim 7, Printout does not teaches the critical data elements include a contract number.

Anderson teaches attaching extra information, such as invoice number, last payment date into a scanned image for reused by different applications (Anderson, [0020]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combine Anderson into Printout to provide extra information with the scanned image, since the combination would have allowed different applications to use such information as Anderson disclosed.

Response to Arguments

8.   Applicant's arguments with respect to claims 1-20 have been considered but are

moot in view of the new ground(s) of rejection.

Applicants argue with respect to claims 1, 14, and 20 that, "**Printout does not**

describe a cover sheet that includes data related to the **content of the document**. Rather,

the cover page described in Printout includes properties of the scanned document, which

properties are related to the characteristics of the electronic image, such as grey-scale,

rotation, color, etc., but not the content of the document" (remarks, pages 11-12).

Applicants further argue that the cover sheet of the applicants' invention "is intended to

hold business information related to the content of the document" (remarks, page 12),

"the cover sheet holds business data related to the content of the document image" and

"the present system automatically creates a workflow" (remarks, page 13).

Examiner respectfully disagrees. As applicants pointed out, Printout's cover page

includes data, such as grey-scale, rotation, color. Because grey-scale, rotation, color are

used to form the document, these data related to the content of the document. It is noted

that the electronic cover is an electronic web form or a electronic cover sheet and

"**business information** related to the content of the document" are not claimed.

Therefore, Printout's teaching perfectly matches the applicants' claimed.

Applicants argue that "the document property values form part of the file (eg.,

grey-tone, number of pixels, rotation, etc.) and they cannot be selectively or dynamically

changed or expanded" (remark, page 12).

Examiner respectfully disagrees. It is noted that applicants claim "data elements are dynamic to reflect updates to the document". Printout teaches the user enters or adjusts data element to reflect changes to the document content (Printout, the user is able to enter "Destination", "Image Control", "Dimensions" and/or "Advanced" information for scanning the image. In "Image Control", when the user selects "Color" mode, "Color Setting" appears and the image is displayed in color (Printout, page 21) and "Advanced" setting is only available at "Color" mode (Printout, pages 21, 24, 26). The user adjusts brightness, contrast and saturation for the image and the image is displayed based on such adjustments (Printout, pages 22-23). Similarly, when the user selects "Grayscale" or "Line Art" mode, different setting is displayed for the user adjusts and the image is displayed based on the user selections and adjustments (Printout, pages 24-27). In "Dimensions", the "Scale" and "Size" of the image are linked together so that when the user adjusts the scale of the image, the size of the image is adjusted as well. The "Scanned Image Size" and "Scanning Resolution" are automatically updated when the user adjusts the data (Printout, pages 5 and 28)).

Applicants argue that "Printout does not use the content of the document as part of the document properties, to store, search, and locate the document".

However, the combination of Ferguson and Printout teaches such limitations as explained in the rejection above.

Applicants argue with respect to claims 8-9, 13, 18-19 based on the arguments of claims 1, 14 and 20 above. Arguments are not persuasive as explained above. Therefore, claims 8-9, 13, 18-19 are rejected as explained in the rejection above.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shimonura et al., US 2002/0095432 A1, filed 01/02, teaches document management system.

Kennedy et al., US 2002/0111911 A1, filed 02/01, teaches document distribution system and method with consolidated document services management.

Murakami et al., US 5,129,016, filed 10/1990, teaches system for registration of document.

Constantin et al., US 2003/0002068 A1, filed 06/01, teaches method of routing and processing document images sent using a digital scanner and transceiver.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V Huynh whose telephone number is (571) 272-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

Thu V. Huynh
November 14, 2005